

United States Patent and Trademark Office

010

DATE MAILED: 11/17/2005

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450

P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/617,927	07/10/2003	Dennis M. Brown	A-71604/RFT/THR (468899-3	3972
7590 . 11/17/2005			EXAMINER	
Traci H. Ropp for Richard F. Trecartin			LILLING, HERBERT J	
Dorsey & Whit	ney LLP			
Intellectual Property Department			ART UNIT	PAPER NUMBER
Four Embarcadero Center, Suite 3400			1651	
San Francisco,	CA 94111-4187			_

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)					
	10/617,927	BROWN					
Office Action Summary	Examiner	Art Unit					
	HERBERT J. LILLING	1651					
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with t	he correspondence address					
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DATE of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period we failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATES (a). In no event, however, may a reply rill apply and will expire SIX (6) MONTHS cause the application to become ABANE	FION. be timely filed from the mailing date of this communication. SONED (35 U.S.C. § 133).					
Status							
1) Responsive to communication(s) filed on							
2a) This action is FINAL . 2b) This							
	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.							
Disposition of Claims							
4)⊠ Claim(s) <u>1-28</u> is/are pending in the application.							
4a) Of the above claim(s) is/are withdrawn from consideration.							
5) Claim(s) is/are allowed.							
6) Claim(s) is/are allowed.							
7) Claim(s) is/are objected to.							
	8) Claim(s)is/are objected to. 8) Claim(s) 1-28 are subject to restriction and/or election requirement.						
ONEN Ciaimos) 1-20 are subject to restriction and/or election requirement.							
Application Papers	/						
9)☐ The specification is objected to by the Examiner.							
10) The drawing(s) filed on <u>10 July 2003</u> is/are: a) accepted or b) objected to by the Examiner.							
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).							
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.							
Priority under 35 U.S.C. § 119							
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage 							
application from the International Bureau (PCT Rule 17.2(a)).							
* See the attached detailed Office action for a list of the certified copies not received.							
Attachment(s)							
1) Notice of References Cited (PTO-892)	4) Interview Sumr						
Notice of Draftsperson's Patent Drawing Review (PTO-948) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date Paper No(s)/Mail Date Other:							

Application/Control Number: 10/617,927 Page 2

Art Unit: 1651

1. Receipt is acknowledged of the prior art information disclosure statement filed September 07, 2004.

- 2. Claims 1-28 are pending in this application.
- 3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - Claims 1-11, drawn to a process for producing homoharringtonine, classified in class 424, subclass 725.
 - II. Claims 12-14 and 18, drawn to a composition comprising homoharringtonine, classified in class 540, subclass 576.
- III. Claims 15-16, drawn to a method of treatment comprising administering composition comprising homoharringtonine, classified in Class 514, subclass 214.03.
- IV. Claims 19-24, drawn to an aqueous solution of HHT, classified in Class 514, subclass 214.03.
- V. Claim 25, drawn to a method of treatment of a host with an aberrant cellular condition comprising administering a cephalotaxine, classified in Class 514, subclass 214.01.

Claims 25-28 will be examined with this Invention.

The inventions are distinct, each from the other because:

Inventions I and II/IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the

Art Unit: 1651

process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process.

Page 3

4. Inventions II/IV and III/V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different product of using that product.

Invention V does not require the specifics of Inventions I, II, III or IV.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, have acquired a separate status in the art because of their recognized divergent subject matter and the search required for one invention is not required for the other invention, thusly the restriction for examination purposes as indicated is proper.

In addition, the search and examination for the multiple inventions would be an extreme burden since each of the inventions require a different computerized search in addition to a search and examination in different classes.

6. In accordance with this Tech Center procedure for restrictions pertaining to Ochiai/Brouwer Rejoinder Policy, the following guidelines will govern:

This examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Application/Control Number: 10/617,927

Art Unit: 1651

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

- 7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
- 8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner Lilling whose telephone number is 571-272-0918** and **Fax Number** is (703) 872-9306 or SPE Michael Wityshyn whose telephone number is 571-272-0926. Examiner can be reached Monday-Thursday from about 5:30 A.M. to about 3:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.J.Lilling: HJL (571) 272-0918 Art Unit 1651

November 14, 2005

Dr. Herbert J. Lilling Primary Examiner

Group 1600 Art Unit 1651